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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/981,411 | 10/16/2001 | George H. Kitchen III | 70008-9101 | 5840 |

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| EXAMINER |
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MEDLEY, MARGARET B

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 01/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|---------------------------------------|-------------------------|--|
| Office Action Summary | Application No. 09/981,411 | Applicant(s) | |
| | Examiner Margaret B. Medley | Art Unit 1714 | |

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11 and 13-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

The amendments filed January 31, 2002 and October 22, 2002 is objected to under the 35 U.S.C. 132 because it introduces new matter into the disclosure. No amendment shall introduce new matter into the disclosure of the invention is stated under the statute of 35 U.S.C. 132.. The added materials which are not supported by the original disclosure is as follows:

On page 1 in the paragraph beginning at line 8 in line 12 after "microbial growth" the insertion of the phrase --- and act as a strong demulsifier;

On page 8, in the paragraph beginning on line 19, in line 21 change "0.03" to --- 0.05---

On page 9, in the paragraph beginning on line 12, in line 13 change "0.3 parts" to --- 0.03. parts ---.

On page 9, the insertion of --- 0.005 --- and the insertion of --- 0.3 ---.

On page 12, in the paragraph beginning on line 6 the deletion in lines 8 and 9.

On page 13, at lines 15 and 20 the deletion of " '462 patent" and insertion of --- prior art - --; on page 14 at line 2 of paragraph 3 the deletion of " '462 composition" and insertion of --- prior art sample ---; and at line 7 of paragraph 3 of page 14 the deletion of " '462" and insertion of --- prior art ---

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 38 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "0.005 and approximately 0.150" limitation is considered as new matter because the said relative proportion was not found in the disclosure and claims as originally filed. Applicants did not point out to the examiner the specific location in the instant application of the said limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-11 and 13-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (and its dependent claims) is confusing and indefinite for the phrase "said fuel additive having a total part by weight of 1" because it is unclear as to what the total parts by weight of 1 is being referenced. The phrase "wherein the resulting concentration level is less than 7.67 ppm in a fuel" is confusing and unclear because a fuel does form a part of the fuel additive. Therefore, the examiner takes the position on record that the latter limitation does not further the said claims. Claim 1 is further indefinite in that it is unclear as to what measurements the parts by weight of organic-metallic compound is based upon.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is indefinite in that it appears to contradict the bridging paragraph of pages 6 to 7 and the second paragraph for the parts by weight for the organic-metallic in the total composition. Also, the claim is confusing in that it is unclear if the same organic-metallic compound is further added or if an additional organic-metallic compound is added. Clarification is requested.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 13-66 for reasons made of record in Paper No. 4 dated July 16, 2002 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen III 4,609,379 and 4,585,462 in view of Valentine et al (Valentine) 5,550,714 (sic 5,510,714) and Hinkamp 4,336,033.

Applicant's arguments filed October 22, 2002 have been fully considered but they are not persuasive.

Contrary to applicant's statement in paragraph 3 on page 5 Paper No. 5 dated October 22, 2002, the Examiner did not find any amendment to page 1 of the instant specification. Therefore new matter rejection based on 35 U.S.C. 132 is maintained.

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The amendment to page 9, at line 3 of paragraph 3, changing "0.3 parts" to --- 0.03 parts -- is considered as new matter and contradict the limitation @ 0.05 and @ 0.15 of originally filed claim 38 and paragraph 3 in line 3 of page 9 in Paper No. 5 dated October 22, 2002. The amendment to page 9 in line 3 of paragraph 3 dated January 31, 2002 in Paper No. 2 is still considered as new matter. The examiner agrees with applicants' conclusion that the amended ranges fall within the broad ranges and preferred ranges as originally filed. However, the examiner fails to see applicant arbitrarily selection of the amended ranged and applicant has failed to point out the basis for arbitrarily selection of such ranges.

The amendment to page 8 in line 3 of the third full paragraph of Paper No. 5 dated October 22, 2002 changing "0.03" to --- 0.05 --- is considered as new matter. Applicant has not provided the basis for arbitrarily selecting the most preferably range as being the more preferably lower range. It is noted that an example containing a single value was held not to be sufficient to support a claimed range containing said value. In re Lukach 169 USPQ 795 (CCPA 1971). Therefore a most preferable range would not be held sufficient to support a range containing said value.

The examiner maintains the position that the deletion of lines 3-4 of paragraph 2 and the insertion at line 3 of paragraph 3 on page 3 of the instant application in Paper No. 2 dated January 31, 2002 constitute new matter. New matter includes deletions and omissions. See MPEP 706.03(0).

The insertion at line 1 of Table 2 on page 13 constitutes new matter because it is unclear from reading the instant specification if the Run values are based on percentage because the baseline value has not been established. The examiner position is that the RPM values for the

fuel economy is not the same testing as the particulate emission testing because different testing were conducted, note MPEP 706.03(0).

The deletion of the “ ‘462 patent”; “ ‘462” composition “and” “ ‘462” at various locations on pages 13 and 14 of the instant application is considered as new matter, note MPEP 706.03(0). Applicant reference to ‘462 is directed to a specific prior art, note page 2 first full paragraph of the instant application. The phrase “prior art” clearly does not make reference to any specific art, MPEP 706.03(0).

The examiner maintains that claim 38 is properly rejected as containing new matter for reasons that the specification is rejected for containing new matter.

Applicants’ amendment to the specification at page 14, lines 2 and 3, line 2-5 and the amendment to claim 3 have over come the rejections previously made of record.

The examiner agrees with applicants’ argument that Kitchen is silent to teachings to the organic-metallic compound. However, Kitchen 4,585,462 clearly teaches a manganese compound containing organic-metallic compound. It is further noted on record that only claims 10 and 11 require the organic-metallic compound to comprise dicyclopentadienyl iron (claim 10) or homologues of dicyclopentadienyl iron (claim 11).

The limitation “resulting concentration level is less than 7.67 ppm in a fuel” added to claim 1 has been giving consideration. However, the wherein clause does not add patentable weight limitation to claim 1 directed to a fuel additive that does not require the presence of a fuel. Thus applicants’ rebuttal arguments presented on pages 8-10 of Paper No. 5 dated October 22, 2002 does not rebut the rejection under 103 that is made of record. Valentine and Hinkamp are

maintained for their teaching features made under the 103 art rejection in Paper No. 4 dated July 16, 2002.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. B. Medley/mn
January 29, 2003

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER